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10/031,499	06/14/2002	Matthias Hessling	10191/2152	6405

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EXAMINER

NGUYEN, CINDY

ART UNIT	PAPER NUMBER
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2161

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/031,499

Applicant(s)

HESSLING ET AL.

Examiner

Cindy Nguyen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/12/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is response to amendment filed 02/12/07.

Response to Arguments

Applicant's arguments, with respect to Claim 20 under Rejections - 35 USC § 112 (remark, page 5) have been fully considered and are persuasive. The rejection has been withdrawn.

Applicant's arguments have been fully considered but they are not persuasive.

applicant's argument in claim 30 under Claim Rejections - 35 USC § 112 (remark, page 5), that the body of the claim clearly indicates the format of the data packet, in response, no where in claim 30 indicates the format of the data packet, the claim is just providing an electronic data packet including location information that includes locating information and description information, wherein the data packet separately contains the locating information and the description information and includes assignment information for assigning at least in part of the locating information to at least a part of the description information, therefore, renders the claims vague and indefinite.

Applicant's arguments under *Claim Rejections - 35 USC § 101* have been fully considered but they are not persuasive.

Applicant amended the claims 19 and 30 including: by one an encoder, decoder and transmitter/receiver and in response to applicant's arguments on claims 19, 30, 31,

33 and 36 (remark, page 5-6) are still allegedly directed to non-statutory subject matter. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result. Specifically, the claimed subject matter does not produce a useful result because the claimed subject matter fails to sufficiently reflect at least one practical utility set forth in the descriptive portion of the specification.

Claims 19, 30 and 36, These claim are software per se and not statutory (computer programs claimed as computer listing per se, i.e., the descriptions of expressions of the programs, are not physical "things". They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035)."

Claims which are broad enough to read on statutory subject matter or on non-statutory subject matter are considered non-statutory. Cf. *In re Lintner*, 458 F.2d 1013, 1015, 173 USPQ 560, 562 (CCPA 1972) ("Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious

subject matter.") During prosecution, applicant can amend to limit the claims to statutory subject matter.

The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101.

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelinesI01_20051026.pdf>

Applicant's arguments under ***Claim Rejections - 35 USC § 102*** have been fully considered but they are not persuasive

In response to Applicant argued on (remark, page 8-10), claims 19, 30, 31 and 33, in the body of claims were not clearly said the location information is for location information of objects for a map, the "location of objects for a map" was only recited in the preamble of these claims.

Claim 36, nowhere recited "location information of object for a map".

Applicant's claims no where said two different contents in the data packet, what it claim is the data packet separately contains the location information and the description information and includes assignment information for assigning at least a part of the locating information to at least a part of the description information. Yee clearly discloses: a data packet (data packet 80, fig. 3 and corresponding text, Yee), the location information including locating information (data packet and its destination) and description information (subscriber ID and subscriber traffic), wherein the data packet separately contains the locating information and the description information, and includes assignment information (packet that carry subscriber

traffic to route such packet 80 to the traffic channels assigned to the identified subscriber unit 92) for assigning at least a part of the locating information to at least a part of the description information (col. 6, lines 60 to col. 7, lines 24, Yee).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Yee is clearly discloses these claims invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claim 30, the claims are silent on the required step to formatting data.

What the realized is a encoding, decoding and transmitting location information of objects for a map, which is different to a method of formatting data. That, therefore, renders the claims vague and indefinite.

Claim Rejections - 35 USC § 101

Claims 19-35 and 37 stand rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant amended the claim 19 as "a method for at least one of electronically encoding, decoding and transmitting location information of objects for a map" is still allegedly directed to non-statutory subject matter. The claim 19 is not statutory, directed to software, per se, lacking storage on a medium, which enable any underlying functionality to occur. The steps are not used to produce the useful and tangible result, whether their execution accomplishes a practical application.

Applicant amended the claim 30 as "a method of formatting data for at least one of electronically encoding, decoding and transmitting location information of objects for a map" is still allegedly directed to non-statutory subject matter. The claim 30 is not statutory, directed to software, per se, lacking storage on a medium, which enable any underlying functionality to occur. The steps are not used to produce the useful and tangible result, whether their execution accomplishes a practical application.

Claims 31, 33 and 36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. 35 U.S.C. 101 reads as follows: an electronically encoding device or electronically decoding device, the claims are just transmitting and receiving the location information of a data packet as processing. Thus the claims are not statutory, directed to software, per se, lacking storage on a medium, which enable any underlying functionality to occur. The steps are not used to

produce the useful and tangible result, whether their execution accomplishes a practical application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 19, 28- 31, 33 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Yee et al. (US 6044323) (hereafter Yee).

Regarding claims 19, 30, 31, 33 and 36, Mannings discloses: A method for at least one electronically of encoding, decoding and transmitting location information (fig. 1 and 2 and corresponding text, Yee), the method comprising:

at least one of encoding, decoding and transmitting location information of a data packet (data packet 80, fig. 3 and corresponding text, Yee), the location information including locating information (data packet and its destination) and description information (subscriber ID and subscriber traffic), wherein the data packet separately contains the locating information and the description information, and includes assignment information (packet that carry subscriber traffic to route such packet 80 to the traffic channels assigned to the identified subscriber unit

92) for assigning at least a part of the locating information to at least a part of the description information (col. 6, lines 60 to col. 7, lines 24, Yee).

Regarding claim 28, all the limitations of this claim have been noted in the rejection of claim 19 above. In addition, Yee discloses: wherein the data packet includes a header part of the location information and a data part of the location information (82, fig. 3 and corresponding text, Yee).

Regarding claim 29, all the limitations of this claim have been noted in the rejection of claim 28 above. In addition, Yee discloses: wherein the header part includes structure information specifying a data structure of the location information, and includes interpreting instructions specifying a purpose of the location information (as data packet has routing code 84 is included to instruct the satellite communication network where to deliver the packet, Yee).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-27, 32, 34, 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yee et al. (US 6044323) (hereafter Yee) in view of Mannings et al. (US 6169515) (Mannings).

Regarding claim 20, all the limitations of this claim have been noted in the rejection of claim 19 above. However, Yee didn't disclose: wherein the locating information includes at least one first coordinate chain that includes at least one first point. On the other hand, Mannings discloses: wherein the locating information includes at least one first coordinate chain that includes at least one first point (col. 14, lines 14-22, Mannings). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the step wherein the locating information includes at least one first coordinate chain that includes at least one first point in the system of Yee as taught by Mannings. The motivation being to enable the method give the instructions as the user negotiates a succession of function (decision points) the user can be directed to any destination, the users who are to be directed to the same exit from the junction are given the same instruction..

Regarding claim 21, all the limitations of this claim have been noted in the rejection of claim 20 above. In addition, Yee/Mannings discloses: wherein the at least one first coordinate chain contains a second point, the at least one first point of the at least one first coordinate chain is specified in absolute coordinates and the second point of the at least one first coordinate chain is specified in relative coordinates, with respect to one of a centroid coordinate and the at least one first point of the at least one first coordinate chain (col. 13, lines 12-38, Mannings).

Regarding claim 22, all the limitations of this claim have been noted in the rejection of claim 21 above. In addition, Yee/Mannings discloses: wherein the at least one first point of the

at least one first coordinate chain is interpreted in a defined direction by the second point of the at least one first coordinate chain (col. 13, lines 12-38, Mannings).

Regarding claim 23, all the limitations of this claim have been noted in the rejection of claim 19 above. In addition, Yee/Mannings discloses: wherein the description information includes at least one first attribute field (col. 7, lines 25-51, Yee).

Regarding claim 24, all the limitations of this claim have been noted in the rejection of claim 23 above. In addition, Yee/Mannings discloses: wherein the at least one first attribute field includes a type specification and description data, and the description data is determined by the type specification with respect to at least one of a name, an accuracy, a direction, a time, a point of interest and a physical link (col. 7, lines 25-43, yee).

Regarding claim 25, all the limitations of this claim have been noted in the rejection of claim 23 above. In addition, Yee/Mannings discloses: wherein the assignment information includes at least one first assignment entry and the at least one first attribute field and the at least one first point of the at least one first coordinate chain are assigned to each other by the at least one first assignment entry (col. 14, lines 15-37, Mannings).

Regarding claim 26, all the limitations of this claim have been noted in the rejection of claim 25 above. In addition, Yee/Mannings discloses: wherein the at least one first assignment entry includes a reference to the at least one first attribute field and a reference to the at least one first point of the at least one first coordinate chain (col. 14, lines 15-37, Mannings).

Regarding claim 27, all the limitations of this claim have been noted in the rejection of claim 25 above. In addition, Yee/Mannings discloses: wherein the at least one first assignment entry includes one of (i) a reference to the at least one first attribute field and a

reference to a plurality of points of coordinate chains of the locating information, and (ii) a reference to a plurality of attribute fields and a reference to the at least one first point of the at least one first coordinate chain¹ (col. 13, lines 12-45, Mannings).

Regarding claim 32, all the limitations of this claim have been noted in the rejection of claims 31 and 20 above. In addition, Yee/Mannings discloses: wherein a definition of the at least one first point of the at least one first coordinate chain is definable as a function of location information query (col. 11, lines 55 to col. 12, lines 4, Mannings).

Regarding claim 34, all the limitations of this claim have been noted in the rejection of claim 33 above. In addition, Yee/Mannings discloses: wherein the location information is at least partially correlatable with data of a first database associated with the decoding device (col. 7, lines 45-48, Mannings).

Regarding claim 35, all the limitations of this claim have been noted in the rejection of claim 34 above. In addition, Yee/Mannings discloses: wherein at least one of location information that is not contained in the first database and location information is not correlated with data of the first database is stored in a second database associated with the decoding device (col. 7, lines 40-48, Mannings).

Regarding claim 37, all the limitations of this claim have been noted in the rejection of claim 20 above. In addition, Yee/Mannings discloses: wherein the at least one first point includes a geographical point (col. 13, lines 12-38, Mannings).

Conclusion

¹ The road junction connected between the roads as reference to the assignment entry.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 571-272-4025. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2161

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cindy Nguyen


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SUPERVISORY PATENT EXAMINER